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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,217	06/07/2000	David Cooper	13665	8681
23389	7590	03/23/2006	EXAMINER	
SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530			PHAN, HUY Q	
			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/589,217

Applicant(s)

COOPER, DAVID

Examiner

Huy Q. Phan

Art Unit

2687

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,5,8-10,16-18,20,21,25,28 and 29 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 3,5,8-10,16-18,20,21,25,28 and 29 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/10/2006 has been entered.

Response to Amendment

2. This Office Action is in response to Amendment filed on date: 02/10/2006. Claims 3, 5, 8-10, 16-18, 20, 21, 25, 28 and 29 are still pending.

Response to Arguments

3. Applicant's arguments with respect to claims 3, 5, 8-10, 16-18, 20, 21, 25, 28 and 29 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 2687

Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 25 recites the limitation "a User Equipment" in line 2 and line 4. It is unclear whether these limitations are referring to the same feature or different features; therefor, making the claim indefinite.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 28 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Bridges (US-6,148,197).

Regarding claim 28, Bridges discloses a method of using User Equipment (fig. 2C) for a mobile communication system (fig. 2A) comprising:

receiving a first list including at least one unique network identifier (col. 6, lines 66-67); and

comparing the received first list with a second list which includes the at least one unique network identifier and is internally stored in the User Equipment for (col. 7, lines

1-3) selectively communicating with at least one of a plurality of networks (col. 7, lines 3-5).

Regarding claim 29, Bridges discloses User Equipment (fig. 2C) for a mobile communication system (fig. 2A) comprising:

means for receiving a first list including at least one unique network identifier (col. 6, lines 66-67); and

means for comparing the received first list with a second list which includes the at least one unique network identifier and is internally stored in the User Equipment (col. 7, lines 1-3) for selectively communicating with at least one of a plurality of networks (col. 7, lines 3-5).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

a) Claims 3 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tiedemann, Jr. (US-5,940,761) in view of Bridges (US-6,148,197).

Regarding claim 3, Tiedemann, Jr. disclose a method of facilitating handover (fig. 2 and its description) from an active network (original system S1) with which User

Equipment (M1-M3) is in communication to another network (destination system S2), the method comprising the steps of:

receiving from User Equipment communicating via the active network an indication of at least one preferred other network ("reports its finding"; col. 11, lines 36-43; also see col. 7, lines 45-59); and

in response thereto, providing to the User Equipment via the active network neighbor cell information for the at least one preferred other network (col. 5, lines 9-15, also see fig. 2 and its description). But, Tiedemann, Jr. does not particularly show the steps of transmitting to the User Equipment a first list having at least one unique network identifier, comparing the first list with a second list which includes the at least one unique network identifier and is internally stored in the User Equipment for selectively communicating with at least one of a plurality of networks, the comparison being performed by the User Equipment. However in analogous art, Bridges teaches the steps of transmitting to the User Equipment a first list having at least one unique network identifier (col. 6, lines 66-67), comparing the first list with a second list which includes the at least one unique network identifier and is internally stored in the User Equipment for (col. 7, lines 1-3) selectively communicating with at least one of a plurality of networks, the comparison being performed by the User Equipment (col. 7, lines 3-5); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Tiedemann, Jr. as taught by Bridges "so as to obtain service from the highest priority wireless carrier available" (see col. 7, lines 1-5).

Regarding claim 25, Tiedemann, Jr. disclose a mobile communications network (fig. 2 and its description) or component thereof including:

means for receiving from User Equipment communicating with the network an indication of a preferred other network ("reports its finding"; col. 11, lines 36-43; also see col. 7, lines 45-59); and

means for supplying neighboring cell information for the preferred other network (col. 5, lines 9-15, also see fig. 2 and its description). But, Tiedemann, Jr. does not particularly show means for receiving by a User Equipment a first list having at least one unique network identifier, means for comparing by the User Equipment the received first list with a second list which includes the at least one unique network identifier and is internally stored in the User Equipment for selectively communicating with at least one of a plurality of networks. However, Bridges teaches means for receiving by a User Equipment a first list having at least one unique network identifier (col. 6, lines 66-67), means for comparing by the User Equipment the received first list with a second list which includes the at least one unique network identifier and is internally stored in the User Equipment (col. 7, lines 1-3) for selectively communicating with at least one of a plurality of networks (col. 7, lines 3-5); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Tiedemann, Jr. as taught by Bridges "so as to obtain service from the highest priority wireless carrier available" (see col. 7, lines 1-5).

b) Claims 16-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Den Heuvel (US-6,223,030) in view of Bridges (US-6,148,197).

Regarding claim 16, Van Den Heuvel discloses a User Equipment (SU 20) for a mobile communications system capable of handover from an active network (communication system 19) with which User Equipment is in communication to another network (UMTS 14) (fig. 1 and col. 1, lines 50-65; also see cols. 3-4) comprising: means for storing a second list of available other networks supplied by the active network (fig. 6 and col. 5, lines 18-24); means for transmitting from the User Equipment an indication of a preference for a network (fig. 1 and col. 1, lines 59-65).

But, Van Den Heuvel does not particularly show means for receiving a first list having at least one unique network identifier, means for comparing the received first list with a second list which includes the at least one unique network identifier and is internally stored in the User Equipment for selectively communicating with at least one of a plurality of networks. However in analogous art, Bridges teaches means for receiving a first list having at least one unique network identifier (col. 6, lines 66-67), means for comparing the received first list with a second list which includes the at least one unique network identifier and is internally stored in the User Equipment (col. 7, lines 1-3) for selectively communicating with at least one of a plurality of networks (col. 7, lines 3-5); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Van Den Heuvel as taught by Bridges "so as to obtain service from the highest priority wireless carrier available" (see col. 7, lines 1-5).

Regarding claim 17, Van Den Heuvel and Bridges disclose the User Equipment according to claim 16. Bridges further discloses that comprising means for updating the stored list of available other networks based on information supplied by the active network (col. 15, lines 35-45).

Regarding claim 18, Van Den Heuvel discloses a User Equipment (SU 20) for a mobile communications system capable of handover from an active network (communication system 19) with which the User Equipment is in communication to another network (UMTS 14) (fig. 1 and col. 1, lines 50-65; also see cols. 3-4) comprising means for transmitting from the User Equipment an indication of a preference for a network (fig. 1 and col. 1, lines 59-65). But, Van Den Heuvel does not particularly show means for receiving a first list having at least one unique network identifier, means for storing a second list of available other networks supplied by the active network, means for comparing the received first list with a second list which includes the at least one unique network identifier and is internally stored in the User Equipment for selectively communicating with at least one of a plurality of networks; means for updating the second list of available other networks based on information supplied by the active network. However in analogous art, Bridges teaches means for receiving a first list having at least one unique network identifier (col. 6, lines 66-67), means for storing a second list of available other networks supplied by the active network (col. 15, lines 35-45), means for comparing the received first list with a second list which includes the at

Art Unit: 2687

least one unique network identifier and is internally stored in the User Equipment (col. 7, lines 1-3) for selectively communicating with at least one of a plurality of networks (col. 7, lines 3-5); means for updating the second list of available other networks based on information supplied by the active network (col. 15, lines 35-45); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Van Den Heuvel as taught by Bridges "so as to obtain service from the highest priority wireless carrier available" (see col. 7, lines 1-5).

Regarding claim 20, Van Den Heuvel and Bridges disclose the User Equipment according to claim 18. Bridges further discloses that comprising means for storing network preference information (col. 15, lines 35-45).

c) Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tiedemann, Jr. and Bridges in view of Chang (US-6,272,315).

Regarding claim 5, Tiedemann, Jr. and Bridges disclose the method according to claim 3. But, Tiedemann, Jr. and Bridges do not particularly show a step of incrementally adding to or subtracting from the list of available networks. However in analogous art, Chang teaches a step of incrementally adding to or subtracting from the list of available networks (col. 7, lines 16-22); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Tiedemann, Jr. and Bridges as taught by Chang Heuvel for purpose of providing the

user with the most needed information of the available networks in order to increase significantly the efficiency of wireless communication service.

d) Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Den Heuvel in view of Bridges and further in view of Chang (US-6,272,315).

Regarding claim 8, Van Den Heuvel disclose a method (fig. 1 and col. 50-65) of operating the User Equipment capable of handover between an active network (communication system 19) and another network (UMTS 14) comprising a stored list of available networks based on information supplied by the active network with which the User Equipment is in communication (col. 2, lines 54-55 and also see cols. 3-4).

But, Van Den Heuvel does not particularly show receiving a first list having at least one unique network identifier, storing a preference for a network in a second list having the at least one unique network identifier and is internally stored in the User Equipment; comparing the received first list with the second list which includes the at least one unique network identifier for selectively communicating with at least one of a plurality of networks. However in analogous art, Bridges teaches receiving a first list having at least one unique network identifier (col. 6, lines 66-67), storing a preference for a network in a second list having the at least one unique network identifier and is internally stored in the User Equipment (col. 7, lines 2-3); comparing the received first list with the second list which includes the at least one unique network identifier (col. 7, lines 1-3) for selectively communicating with at least one of a plurality of networks (col. 7, lines 3-5); therefore, it would have been obvious to one of ordinary skill in the art at

the time the invention was made to modify the system of Van Den Heuvel as taught by Bridges "so as to obtain service from the highest priority wireless carrier available" (see col. 7, lines 1-7).

But, Van Den Heuvel and Bridges do not particularly show a step of incrementally adding to or subtracting from the list of available networks. However in analogous art, Chang teaches a step of incrementally adding to or subtracting from the list of available networks (col. 7, lines 16-22); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Van Den Heuvel and Bridges as taught by Chang for purpose of offering the user with the most needed information of the available networks in order to provide the most efficient wireless communication service.

Regarding claim 9, Van Den Heuvel, Bridges and Chang disclose method of claim 8. Van Den Heuvel further discloses a step of signaling to the active network (communication system 19) with which the User Equipment is in communication a preferred other network (UMTS 14) for handover (col. 1, lines 50-65 and also see cols. 3-4).

Regarding claim 10, Van Den Heuvel, Bridges and Chang disclose method of claim 9. Van Den Heuvel further discloses wherein said preferred other network is selected by the User Equipment from a list of available networks supplied by the network (col. 1, lines 50-65).

e) Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Van Den Heuvel and Bridges in view of Gourgue (US-6,584,116).

Regarding claim 21, Van Den Heuvel and Bridges disclose the User Equipment according to claim 16. But, Van Den Heuvel and Bridges do not particularly show wherein the active network is a UMTS network and the other network is a GSM network, having means for communicating over both networks. However in analogous art, Gourgue teaches wherein the active network is a UMTS network and the other network is a GSM network, having means for communicating over both networks (col. 2, lines 15-45); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Van Den Heuvel and Bridges as taught by Gourgue for purpose of allowing the User Equipment with capability continuously communicating while moving from UMTS network to GSM network.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) Hooper discloses that "the mobile terminal 60 compares the acquired system identification information to the system identification information stored in memory for the highest ranking" (see specification).


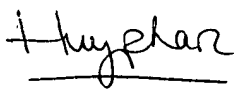
b) Agre discloses that "The subscriber unit selects the most preferred one of the service providers at step 128 by comparing against a pre-stored list, and transmits the

corresponding service provider ID at step 130 which the gateway receives at step 132 on the assigned traffic channel" (see specification).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Q Phan whose telephone number is 571-272-7924. The examiner can normally be reached on 8AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



GEORGE ENG
SUPERVISORY PATENT EXAMINER